

**REMARKS**

Claims 38-41, 44-51, 54-61, and 64-70 remain pending.

In the Office Action<sup>1</sup> mailed February 25, 2008, the Examiner rejected claims 38-41, 44-46, 48-51, 54-56, 58-61, 64-66, and 68-70 under 35 U.S.C § 102(e) as being anticipated by U.S. Patent 6,987,945 to Corn et al. ("*Corn*"); and rejected claims 47, 57, and 67 under 35 U.S.C § 103(a) as being unpatentable over *Corn* in view of U.S.

Published Patent Application No. 2002/0032790 to Linderman ("*Linderman*").

Applicants respectfully traverse each of these rejections.

**I. Examiner Interview**

Applicants thank the Examiner for granting the April 17, 2008 telephonic interview with Applicants' representative. As mentioned in the April 21, 2008 Interview Summary, the Examiner and Applicants' representative discussed the *Corn* reference during the interview. Moreover, as discussed in the interview, Applicants encourage the Examiner to contact the Applicants' representative if a further interview may expedite prosecution.

**II. Rejection under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the rejection of claims 38-41, 44-46, 48-51, 54-56, 58-61, 64-66, and 68-70 under 35 U.S.C § 102(e) as being anticipated by *Corn*.

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

In order to properly establish anticipation under 35 U.S.C. § 102, “each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131. Here, *Corn* does not disclose each and every element of the pending claims.

Independent claim 38 recites a method for providing access to an electronic course that is hosted by an external system, including, “transmitting, by the server, a track command to the external system for tracking the user activity through the at least one selected course.” *Corn* fails to disclose at least the claimed “track command.”

With reference to Figure 1, *Corn* discloses a client electronic device 16 for retrieving a web page of educational content from web server 4. *Corn*, col. 2, lines 50-60. The web page includes a client side applet 14. *Id.* at Figure 1. When the web page is viewed at client 16, applet 14 records the amount of time a user of client device 16 spends viewing the web page. *Id.* at lines 60-67. Client 16 forwards this amount of time to an educational provider. *Id.* at col. 3, lines 1-8. This educational provider uses the amount of time to determine whether the user of the client device 16 should receive credit for the educational content viewed. *Id.*

*Corn*’s applet 14 cannot correspond to the claimed “track command.” For example, *Corn*’s applet is not “transmitt[ed] to the external system,” as recited in claim 1 (emphasis added). Instead, *Corn*’s applet is transmitted to the client 16 (alleged “user”).

See Office Action, pages 2 and 3. Indeed, *Com* is silent with respect to the claimed “external system.”

Furthermore, *Com*’s elapsed time also cannot constitute the claimed “track command.” For example, *Com*’s elapsed time is not “transmitt[ed] by a server,” as recited in claim 1 (emphasis added). Instead, *Com*’s elapsed time is transmitted by the applet on the client.

Accordingly, *Com* does not disclose at least the claimed “track command.” For at least these reasons, *Com* fails to anticipate claim 1.

Independent claims 48, 58, and 68-70, while of different scope than independent claim 38, comprise similar recitations as claim 38. Accordingly, *Com* fails to anticipate claims 48, 58, and 68-70 for at least the reasons discussed previously.

Claims 39-41, 44-46, 49-51, 54-56, 59-61, and 64-66 depend from one of claims 38, 48, and 58. Accordingly, *Com* fails to anticipate claims 39-41, 44-46, 49-51, 54-56, 59-61, and 64-66 at least due to their dependence.

### **III. Rejection under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 47, 57, and 67 under 35 U.S.C § 103(a) as being unpatentable over *Com* in view of *Linderman*. No *prima facie* case of obviousness has been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]jections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claims 47, 57, and 67 depend from claims 38, 48, and 58, respectively, and therefore, include all recitations therein. As discussed previously *Corn* fails to teach or suggest each and every element of claims 47, 57, and 67.

*Linderman* fails to cure the deficiencies of *Corn*. That is, *Linderman* fails to teach or suggest “transmitting, by the server, a track command to the external system for tracking the user activity through the at least one selected course,” as recited in claim 38. Accordingly, *Corn* and *Linderman* fail to disclose each and every element of claims 47, 57, and 67.

In view of the failure of the prior art to teach or suggest a combination including the elements of claims 47, 57, and 67 discussed above, the Office Action has failed to properly determine the scope and content of the prior art and to properly ascertain the differences between the prior art and the claimed invention. Thus, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill, in view of the prior art. Accordingly, no *prima facie* case of obviousness has been established, and the Examiner should withdraw the rejection of claims 47, 57, and 67 under 35 U.S.C. § 103(a).

#### **CONCLUSION**

In view of the foregoing, Applicants respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 12, 2008

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